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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218001
Party	Defendant MYCOSKIE, LLC
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Date	09/30/2014
Attachments	91218001.PDF(52762 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 86/004044
Filed: July 8, 2013
Published in the *Official Gazette* on April 29, 2014
For the mark: TOMS

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TOD'S S.P.A.,	:	
	:	
<i>Opposer,</i>	:	OPPOSITION NO.: 91218001
	:	
v.	:	
	:	
MYCOSKIE, LLC,	:	
	:	
<i>Applicant.</i>	:	
	:	
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ANSWER TO NOTICE OF OPPOSITION

Applicant Mycoskie, LLC ("Applicant"), by and through its undersigned counsel, hereby answers the Notice of Opposition filed by Tod's S.p.A. ("Opposer") against Applicant's application to register the word mark TOMS, identified in Application Serial No. 86/004044 ("Applicant's TOMS Mark") in International Class 18, as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and accordingly denies such allegations.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2, and accordingly denies such allegations.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3, and accordingly denies such allegations.
4. Applicant admits the allegations in Paragraph 4.




5. Applicant admits the allegations in Paragraph 5.
6. Applicant denies the allegations in Paragraph 6.
7. Applicant denies the allegations in Paragraph 7.
8. Applicant denies the allegations in Paragraph 8.
9. Applicant denies the allegations in Paragraph 9.
10. Applicant denies the allegations in Paragraph 10.

FACTS COMMON TO ALL AFFIRMATIVE DEFENSES

1. Applicant is the proprietor of the well-known TOMS brand for footwear, eyewear, apparel, and other related products and services. Applicant's TOMS mark has been continuously in use in the United States since May 2006.
2. Applicant owns the following federal trademark registrations and/or pending applications for the TOMS word mark for various related goods and services (collectively, the "TOMS Marks"):

International Class and Goods/Services	Reg. No./ Serial No.
25 (Canvas shoes, Shoes)	Reg. No. 3,353,902 Reg. Date: 12/11/07 Status: Incontestable as of 11/30/13
25 (Clothing, namely, canvas shoes, shoes, caps, shirts, t-shirts and hats)	Reg. No. 3,566,093 Reg. Date: 1/20/2009 Status: Incontestable as of 4/1/14
25 (Clothing, namely, hoods, jerseys, tops and jackets)	Reg. No. 3,662,112 Reg. Date: 7/28/09 Status: Section 8 & 15 filed 8/28/14

International Class and Goods/Services	Reg. No./ Serial No.
25 (clothing, namely, one piece garments for infants and babies)	Reg. No. 4,097,948 Reg. Date: 2/14/12
9 (Sunglasses and cases for sunglasses)	Reg. No. 4,192,925 Reg. Date: 8/21/12
9 (Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefore)	Reg. No. 4,313,981 Reg. Date: 4/2/13
35 (On-line retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters; Retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters)	Reg. No. 4,410,344 Reg. Date: 7/16/13
30 (Coffee and coffee-based beverages; and artificial coffee)	Reg. No. 4,602,798 Reg. Date: 9/9/14
30 (Tea; cocoa)	Ser. No. 85/965,239 App. Date: 1/20/13 Status: Published for Opposition on 12/3/13, not opposed

3. Applicant also owns numerous applications and registrations for the mark TOMS and Design (), including applications including Class 18 for the same goods as Applicant's TOMS Mark, namely,  (Ser. No. 86/004,053), and  (Ser. No. 86/242,690) (collectively, the "TOMS and Design Marks"). The foregoing marks have been published for opposition, and have not been opposed.

4. Opposer has never filed any opposition or cancellation proceedings against any of the TOMS Marks or TOMS and Design Marks referenced in Paragraphs 2 and 3 above, and all such marks have either registered, or are awaiting registration.

5. Since at least as early as May 2006, identical and/or related products and services bearing the TOMS Marks and Opposer's TOD'S mark have coexisted in the United States marketplace — frequently being sold in the very same retail locations, including, without limitation, the Nordstrom and Neiman Marcus department store chains — without any known instances of actual confusion, or any indication whatsoever that confusion is likely.

AFFIRMATIVE DEFENSES

6. The Notice of Opposition fails to state a claim upon which relief can be granted.

7. Opposer is barred from any relief because there is no likelihood of confusion between Applicant's TOMS Mark and Opposer's TOD'S mark.

8. Opposer is barred from any relief because Applicant owns prior registrations for essentially the same mark in connection with essentially the same goods and/or services as Applicant's TOMS Mark.

9. Opposer is barred from any relief under the doctrine of estoppel.

10. Opposer is barred from any relief under the doctrine of waiver.

11. Opposer is barred from any relief under the doctrine of laches.

12. Opposer is barred from any relief under the doctrine of acquiescence.

13. Opposer is barred from any relief under the doctrine of unclean hands.

PRAYER FOR RELIEF

WHEREFORE, Applicant respectfully prays that the Board dismiss the Opposition and grant registration of Applicant's TOMS Mark on the Principal Register in International Class 18.

Dated: September 30, 2014

Respectfully submitted,

ARNOLD & PORTER LLP

By: /Louis S. Ederer/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 30, 2014 a copy of the foregoing
ANSWER TO NOTICE OF OPPOSITION was served by First Class Mail upon the following
counsel of record for Opposer Tod's S.p.A.:

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